

Atty. Dkt. No. 054707-0868

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barbara S. SLUSHER et al.

Title: NAALADASE INHIBITORS
FOR TREATING RETINAL
DISORDERS AND
GLAUCOMA

Appl. No.: 09/866,961

Filing Date: 05/30/2001

Examiner: Zohreh A. FAY

Art Unit: 1614

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement dated October 23, 2002, Applicants hereby provisionally elect Group VII, claims 25-26, for examination, with traverse.

TRAVERSE

The Commissioner may require restriction if two or more independent and distinct inventions are claimed in one application (35 U.S.C. § 121). The Office must provide reasons for restriction based on separate classification, separate status in the art, or a different field of search (M.P.E.P. § 808.02).

The Office has required restriction between twelve (12) groups, some limited to only 2-3 claims, without providing proper basis for doing so. The Office has not shown separate classification, separate status in the art, or a different field of search. In fact, the Office has stated that several Groups would require search in the same classes and subclasses. For example, the Office stated that provisionally elected Group VII is drawn to compounds classified in class 514, subclass 568 (Office Action, page 2, last 3 lines). But the Office stated that Groups VIII, IX, and X are classified in the same class and subclass (Office Action, page 3, lines 1-9). The Office would face no undue burden in searching Groups VII-X together because the identical class and subclass would be searched. Similarly, the Office stated that Groups I and II are both classified in class 514, subclasses 572 and 573 (Office Action, page 2, lines 2-7), and the Office stated that Groups IV, V and VI are classified in class 514, subclasses 252.1 and 222.2 (Office Action, page 2, lines 11-19).

The Office stated that each group “is directed to totally different chemical structure” (Office Action, page 3, 4th line from the bottom). But the Office thereby ignores that the groups share structural and functional features. All the groups recite formulas that require a carboxy group, and most also require a phenyl ring. And all the groups relate to compounds that are NAALADase inhibitors.


For the reasons mentioned above, Applicants respectfully request that the Office withdraw the restriction requirement or at least reduce the Groups to a reasonable number based on the similar classifications of certain Groups as described above.

CONCLUSION

Applicants have provisionally elected Group VII, Claims 25-26, for examination.
Please charge or credit Deposit Account No. 19-0741 for all fees as needed.

Respectfully submitted,

Date 12-NOV-2002

By 

FOLEY & LARDNER
Customer Number: 29728
29728

Rouget F. Henschel
Attorney for Applicant
Registration No. 39,221

PATENT TRADEMARK OFFICE
Telephone: (202) 295-4164
Facsimile: (202) 672-5399